

Attorney Docket No.: J6638(C)  
Serial No.: 09/930,320  
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**BRIEF FOR APPELLANT**

Sir:

This is a Brief on appellant's Appeal from the Examiner's Final Rejection concerning the above-identified application. The Commissioner is hereby authorized to charge any additional fees, which may be required to our deposit account No. 12-1155, including all required fees under: 37 C.F.R. §1.16; 37 C.F.R. §1.17; 37 C.F.R. §1.18; C.F.R. §1.136.

## BRIEF FOR APPELLANT

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## **I. REAL PARTY IN INTEREST**

Unilever Home & Personal Care USA, Division of Conopco, Inc. is the real party in interest, a corporation organized and existing under and by virtue of the laws of the State of New York and having a place of business at 33 Benedict Place, Greenwich, Connecticut 06830.

## **II. RELATED APPEALS AND INTERFERENCES**

There are no other prior or pending appeals or interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending Appeal.

## **III. STATUS OF CLAIMS**

The application was originally filed with claims 1 to 29. Claims 1-11 and 13-29 remain in the case and are the subject of this appeal. The claims on appeal are included in the Appendix.

## **IV. STATUS OF AMENDMENTS**

A request to reopen prosecution according to 37 C.F.R. § 41.50(b)(1) and an amendment to claims 1 and 19 was filed on October 25, 2005.

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

The invention relates to the general area and art of the customized formulation of personal care products. Personal care products are widely available, however, a drawback of such products is that the user cannot alter the formulation to accommodate their particular skin and hair characteristics, personal preferences, or to provide specialized treatment for skin and hair conditions. A further drawback of such personal care products is the uncertainty of the age and freshness of the prepared formulations which may have been prepared many months or years before the product is sold.

Therefore, one aspect of the invention is to provide a method for providing a customized personal care product to the consumer at a location remote from the location in which a personal care product base composition was prepared. The customized product produced by the inventive method will have the following two components: 1) a product base (e.g. body wash base, hair shampoo base, skin toner base, etc.) selected by the consumer; and 2) at least two separate classes of performance agents (e.g. fragrance, emollient, botanical extracts, other skin actives for treating skin conditions, etc.) also selected by the consumer. The base and the at least two performance agents are combined to form a finished personal care product. Product base compositions are defined in the specification on page 4, line 30 through page 5, line 10. Product base compositions may include a thickener. See, e.g., page 5, lines 22 – 25.

The separate choices within each performance agent class available to the consumer are called “variants”. So in the case of the fragrance performance agent, one variant will be, e.g., fragrance #1, and a second variant will be a different fragrance, e.g., fragrance #2, as illustrated in Table 1A on page 10 of the instant specification. A second performance agent called a “Benefit” agent is also illustrated in Table 1A. A further limitation of the inventive method is that the first and second class of performance agents are independently selected from specific defined classes of

materials limited to fragrances, colorants, benefit agents or blends thereof that are defined in the specification on page 2, lines 11-16; page 6, line 11 and line 29.

Each of the performance agents is dissolved in a "vehicle". A further requirement according to the claims is that all of the vehicles for each separate class of performance agent have at least two ingredients in common with each other. This is also illustrated in Table 1A. A further requirement for the inventive method as claimed is that the first vehicle is compatible with both the personal care base composition and the second class of performance agents.

The inventive method further provides that the consumer may select in any sequence one personal care base composition and at least one variant from the first class of performance agents and at least one variant from the second class of performance agents. These ingredients are then dosed into a container to form a personal care product and the product is blended until uniform.

The claims to the subject invention as presently in the case clearly set forth and define a method for selecting a customized personal care product as opposed to prior art customizable products. This is borne out when one reviews the independent claim 1 in the application, wherein it is specifically recited that the method concerns itself only with a personal care product base that is prepared at a location that is remote from the location that the customized product is prepared, that the performance agents must have certain specific defined properties, and directly relevant to the Board's decision (see Decision on Appeal, page 8, lines 1-3) that neither the first nor second class of performance agents include a thickener which excludes a specific group of materials (performance agents).

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

### **35 U.S.C. §103(a)**

Claims 1-5, 7-11, 13-19, 22 and 25-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rath, et al. (USP 5,972,322), in view of Stewart (WO 98/30189).

Claims 6, 20 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rath, et al. (USP 5,972,322), in view of Stewart (WO 98/30189), and in further view of Rigg, et al. (USP 5,622,692).

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rath, et al. (US 5,972,322), in view of Rigg, et al. (US 5,622,692), and Stewart (WO 98/30189) and in further view of Tartaglione (US 4,851,062).

## **VII. ARGUMENT**

A. The examiner's rejection of claims 1-5, 7-11, 13-19, 22 and 25-29 under 35 U.S.C. 103(a) as being unpatentable over Rath, et al. (US 5,972,322 of record), (US'322) in view of Stewart (WO 98/30189 for reasons set forth in the prior office action, should be reversed.

Rath, et al., relates to a system for combining disparate and separate components to form a customized hair care formulation where the thickener is separate from the product base and is separately added after other enhancing agent ingredients have been added (see, e.g., column 1, lines 33-40, 51-55 and line 65 to column 2, line 1). Rath, et al., describes in all cases a low viscosity base which can be selected, a second package containing a compatible thickening composition, and where a wide variety of enhancing additives may be added. Rath, et al., teaches away from the

present invention where the inventive base composition (where appropriate) already comprises a thickening agent (see page 5, lines 21-25) and was formulated at a location remote from the location that the finished personal care product is prepared in.

Moreover, amended claim 1 makes clear that the first and second class of performance agents are independently and specifically selected from fragrances, colorants, benefit agents and blends thereof (see instant specification page 2, lines 12-16, 21). Such performance agents can not be thickening agents since thickening agents are separately defined as being part of a base composition (see page 4, line 30 to page 5, line 10) and as stated above must be added to the base composition at a location that is different than where the performance agents are added. Claim 1 has been further amended responsive to the Board's decision (see Decision on Appeal, page 8, lines 1-3), to explicitly exclude thickening agents that are not defined as performance agents as defined in the specification and to further distinguish the instant invention from Rath, et al.

Furthermore, Rath, et al., describes that the hair care system which includes a base, a thickener and separate enhancing additives are pre-packaged in the form of a kit (see col. 13, lines 24-27). By specifying multi-part product kits, Rath, et al., teaches clearly that each of the component parts of the kit should be pre-selected by a person other than the consumer, i.e., the kit supplier. The consumer is not intended to be involved in the packaging of the kits disclosed in Rath, et al., but only in the possible mixing of certain kit components. In contrast, in the present invention, the consumer selects, in any sequence, at least one personal care base composition, at least one variant from the first class of performance agents, and at least one variant from the second class of performance agents. Thus, in the present invention, the component parts of the product are not dictated by a pre-packaged kit selected according to the desire or whim of an unspecified person but by the precise needs of the consumer. The choice of components in the kits of Rath, et al., will be limited and, as a result, the consumer may not be able to obtain the precise combination of components which they would like to have (see page 1, lines 22-28 in the instant specification).

Stewart teaches a computer controlled device for evaluating consumer test results and preferences (page 16, lines 10-20). The system includes a base composition and one or more additives that are added to the base (page 22, lines 4-6). Stewart discusses what the principal components of the additives are (page 23, lines 2-6) but is silent about how each additive relates to the other with respect to any ingredients that may be in common with each other. Stewart merely states that additives will typically be dissolved in a solvent, such as water, alcohol or an oil (page 22, lines 18-19). See also Examples 1-10 on pages 26-32 which discuss all the additional ingredients that can be added to the indicated cosmetic bases but are silent on how the ingredients in each additive relate to each other. Therefore, Stewart does not disclose or suggest the vehicle of each additive have at least two ingredients in common.

The examiner asserts that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references with respect to applicants' previous arguments. However, it is well settled that the examiner cannot pick and choose among individual elements of assorted prior art references to re-create the claimed invention based on the hindsight of the applicants' invention. Rather, the examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claim combination. See Smith Klein Diagnostics Inc. v. Helena Laboratories Corp., 8 USPQ 2d 1468 (Fed.Cir. 1985). Additionally, the mere fact that it is possible to find isolated disclosures which might be combined in such a way as to produce a new system, does not necessarily render such a system obvious unless the art also contains something to suggest the desirability of the proposed combination, i.e., the motivation to combine the references. In re Grabiak, 226 USPQ 870, 872 (Fed.Cir. 1985).

B. The examiner's rejection of claims 6, 20 and 21 under 35 U.S.C. 103(a) as being unpatentable over Rath, et al. (US 5,972,322 of record), in view of Stewart (WO



98/30189), and in further view of Rigg, et al. (US 5,622,692 of record), for reasons set forth in the prior office action, should be reversed.

Rigg, et al., discloses the method and apparatus for customizing facial foundation products. As in Stewart, Rigg, et al., discloses a wide range of additives that may be added to a particular formulation (see col. 2, lines 61-62). As in both Rath, et al., and Stewart, there is no disclosure or suggestion regarding how the various additives relate to each other with respect to ingredients in each additive that may be in common with each other. Therefore, Rigg, et al., does not disclose or suggest the vehicle of each additive to have at least two ingredients in common.

C. The examiner's rejection of claims 23 and 24 under 35 U.S.C. 103(a) as being unpatentable over Rath, et al. (US 5,972,322), in view of Rigg, et al. (US 5,622,692), and Stewart (WO 98/30189) and in further view of Tartaglione (US 4,851,062) for reasons set forth in the prior office action, should be reversed. Tartaglione discloses a method of making a plastic container having a neck. Tartaglione does not disclose how personal care products can be custom formulated nor the relationship of the ingredients that are required by the inventive method of custom formulating such products. There would be no motivation to one skilled in the art to combine Rath, et al., in view of Rigg, et al., and Stewart in further view of Tartaglione to obtain the invention of claims 23 and 24 absent impermissible hindsight of Appellant's invention.

In conclusion, the method of the present invention constitutes an improvement in the art. It is distinguished by its claims over the art. It is novel and unobvious. Claims 1-11 and 13-29 should be allowed. Appellants respectfully request the Board of Patent Appeals and Interferences to reverse the Examiner's final rejections under 35 U.S.C. § 103(a).

## VIII. CLAIMS APPENDIX

1. A method for providing a customized, personal care product to a consumer at a location remote from a second location in which a personal care product base composition is prepared, comprising:
  - (a) providing a selection from a plurality of said personal care base compositions;
  - (b) providing a selection from a plurality of variants from a first class of performance agents, each of said variants being delivered in a first vehicle, said first vehicle for each of said variants having at least two ingredients in common with each other, said first vehicle being compatible with a mixture of said personal care base composition and a second class of performance agents different from the first class;
  - (c) providing a selection from a plurality of variants of said second class of a performance agents, each of said variants being delivered in a second vehicle, said second vehicle for each of said variants having at least two ingredients in common with each other;
  - (d) permitting the consumer to select, in any sequence, said at least one personal care base composition; at least one variant from said first class of performance agents; and at least one variant from said second class of performance agents;
  - (e) dosing, in a predetermined sequence, the consumer selected personal care base composition and performance agents into a container to form a personal care product; and
  - (f) mixing said personal care product until the product is uniform; wherein said first and second class of performance agents are independently selected from fragrances, colorants, benefit agents and blends thereof; and
  - (g) wherein said first and second class of performance agents do not include a thickener component other than component(s) selected from botanical extracts, emollients, vegetable oils, active agents for treating or preventing skin disorders, vitamins, fragrances and colorants.

2. The method of claim 1 wherein said second vehicle for each variant has at least three ingredients in common.
3. The method of claim 1 wherein a sufficient quantity of a blank composition is dosed in said container, in substitution for at least one performance agent, whereby the final concentration of base product ingredients in said personal care composition is adjusted to be substantially equal to that of a final product where no substitution of said performance agents was made.
4. The method of claim 3 wherein said blank composition has at least two ingredients in common with any one of said performance agents.
5. The method of claim 1 wherein said customized personal care product is selected from a body wash, a body lotion a body mist spray, a hydroalcoholic toner, a facial cleansing gel, a hand cleanser, a hair shampoo, a hair conditioner, a face lotion, a deodorant, a bar soap, a bath foam, and bath salts.
6. The method of claim 1 wherein a customized label is applied to the container identifying the product and only the components of the base formula and dosed performance agents contained therein.
7. The method of claim 1 wherein said first class of performance agents are fragrances.
8. The method of claim 7 wherein each of said fragrances contain a solvent and at least one preservative in common with each other.
9. The method of claim 8 wherein said solvent is selected from water, a monohydric alcohol, a polyhydric alcohol, or a blend thereof.

10. The method of claim 8 wherein said preservatives are selected from DMDM Hydantoin, Iodopropynyl Butylcarbamate, polyaminocarboxylic acid chelates or salts thereof, and phosphonate chelates.
11. The method of claim 7 wherein at least one fragrance selection has a plurality of scent intensity levels selectable by the consumer.
13. The method of claim 1 wherein said second class of performance agents are benefit agents.
14. The method of claim 13 wherein at least one benefit selection has a plurality of benefit intensity levels selectable by the consumer.
15. The method of claim 2 wherein said second vehicle's common ingredients include a solvent, a solubilizing agent, and a preservative.
16. The method of claim 14 wherein said solvent is selected from water, a monohydric alcohol, a polyhydric alcohol, or a blend thereof.
17. The method of claim 14 wherein said solubilizing agent is selected from at least one of a polyethylene glycol ether of a fatty alcohol, a polyethylene glycol ether of hydrogenated castor oil, a polyethylene glycol derivative of a sorbitan ester, propylene glycol, a polysorbate, a glycerol ester, a polyethylene glycol derivative of a glycerol ester, an alkyl phosphate and an alkyl sulfate.
18. The method of claim 14 wherein said preservatives are selected from DMDM Hydantoin, Iodopropynyl Butylcarbamate, polyaminocarboxylic chelates, and phosphonate chelates.

19. The method of claim 1, comprising dosing a third class of performance agent different from said first and second class of performance agent, said third class of performance agent having at least two ingredients in common with at least one of said first and second class of performance agents; said third class of performance agent being compatible with said product base, and said first and second class of performance agents; and wherein said third class of performance do not include a thickener component other than component(s) selected from botanical extracts, emollients, vegetable oils, active agents for treating or preventing skin disorders, vitamins, fragrances and colorants.
20. The method of claim 6 wherein the label contains a code capable of tracking the identity of both the product and the consumer for later reference.
21. The method of claim 20 wherein the code is in the form of a machine scannable bar code.
22. The method of claim 1 where said container has a volume under about 1 liter.
23. The method of claim 22 wherein said container has a neck; a plug is inserted in said container's neck after said container has been filled to a level below said neck; said plugged neck is then capped; said plug occupying at least 50% of the volume of said neck to improve mixing efficiency when said container's contents are blended by a mixing device while said container is situated in a position substantially inverted from its filling position.
24. The method of claim 22 wherein said container has a neck; a cap without an orifice is used to cap said container to improve mixing efficiency when said container's contents are blended by a mixing device while said container is situated in a position substantially inverted from its filling position.

25. The method of claim 1 wherein said container is agitated while its major axis is positioned at an angle greater than 10 degrees from the vertical.
26. The method of claim 25 wherein said angle is greater than 30 degrees from the vertical.
27. The method of claim 1 wherein said personal care product base has a viscosity in the range of about 0.9 to 100,000 cps at 25° C.
28. The method of claim 1 wherein said product base's viscosity is in the range of about 0.9 to 30,000 cps at 25° C.
29. The method of claim 1 wherein said second location is a retail location.

**IX. EVIDENCE APPENDIX**

No evidence pursuant to 37 C.F.R. §§ 1.130, 1.131 or 1.132 or any other evidence has been entered by the examiner and relied upon by the appellant in this appeal.

**X. RELATED PROCEEDINGS APPENDIX**

No decisions have been rendered by a court or the Board in any proceeding related to this appeal.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Alan A. Bornstein", written over a horizontal line.

Alan A. Bornstein  
Registration No. 40,919